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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,913

05/19/2006

Hiroko Udagawa

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EXAMINER

ORWIG, KEVIN S

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

12/30/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/579,913

Applicant(s)

UDAGAWA ET AL.

Examiner

Kevin S. Orwig

Art Unit

1611

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 17 December 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 12-15.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Allison M. Ford/  
Primary Examiner, Art Unit 1651

Continuation of 11. does NOT place the application in condition for allowance because: The arguments presented by applicants are unpersuasive for at least the following reasons.

REJECTIONS MAINTAINED:

Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over BRACHT in view of NAKANO as evidenced by U.S. 6,689,379.

RESPONSE TO ARGUMENTS:

Applicants argue that the references do not suggest a "copolymer obtained by copolymerization of monomers containing 2-ethylhexyl(meth)acrylate and an alkyl(meth)acrylate whose alkyl group is linear and has 6 to 20 carbon atoms (response, pgs. 5-6). This argument was addressed in the Final Office Action dated 6/23/10. The examiner understands applicants' concern, but believes that applicants are too narrowly interpreting the teachings of Nakano. Nakano clearly teaches that suitable acrylic adhesives for the invention include polymers AND COPOLYMERS obtained by polymerizing alkyl(meth)acrylates, including 2-ethylhexyl (meth)acrylate and dodecyl (meth)acrylate (col. 3, lines 40-50; par. 1 as labeled by applicants in the response). Applicants appear to suggest that the copolymers taught by Nakano must ONLY be those containing a single alkyl(meth)acrylate from par. 1 and monomers from par. 3. However, Nakano never states this. In fact, par. 2 states that the copolymer MAY be one produced from the monomers discussed in par. 3. One of skill in the art reading Nakano would understand and/or immediately contemplate that the copolymer taught by Nakano can include more than one of the species listed in par. 1. This is clear from Nakano's teaching of "polymers AND copolymers obtained by polymerization of alkyl(meth)acrylate" in the first two lines of par. 1. Applicants misinterpret the last sentence of par. 1, and suggest that it somehow refers to the monomers discussed in pars. 2-3. But that is not the case. The last sentence of par. 1 says nothing about the monomers discussed later. That is certainly one embodiment, but the teaching is clearly not limited to this. By the last sentence of par. 1, an artisan would understand that at least one of the species from par. 1 must be in a proportion of at least 50% wt, more preferably at least 60%, but that does not defeat Nakano's teaching of copolymers in the first 2 lines of par. 1, which suggest that combinations of the species in par. 1 can be used.

Applicants argue that the random chance of an artisan selecting the claimed combination is small (response, p. 6). Applicants are reminded that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007) (quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (Id.). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that "[a] person of ordinary skill is... a person of ordinary creativity, not an automaton." Id. at 1742. Consistent with this reasoning, it would have been obvious to have selected various combinations of the monomers directly taught by Nakano, to arrive at compositions "yielding no more than one would expect from such an arrangement", in this case an adhesive capable of maintaining a high concentration of dissolved tulobuterol.

It is completely within the purview of the skilled artisan to obtain, by no more than routine experimentation, the claimed polymer based on Nakano's teachings. No evidence of unexpected results has been presented or argued. .